

Remarks

Claim 8 has been amended to correct typographical errors. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

Claim Status

Claims 1-30 are pending in the Application.

Claims rejected: 1, 8, and 12-13

Claims objected to: none

Claims (presumed) allowed: 2-7, 9-11, and 14-30

The Claim Rejections

- 1). Claim 12 was rejected pursuant to 35 U.S.C. § 112, first paragraph.
- 2). Claim 8 was rejected pursuant to 35 U.S.C. § 112, second paragraph.
- 3). Claim 1 was rejected as a provisional double patenting rejection pursuant to 35 U.S.C. § 101 as claiming the same invention over each of:
 - 3A). claim 1 of application 10/980,209.
 - 3B). claim 1 of application 10/957,287.
- 4). Claim 1 was provisionally rejected as unpatentable under the judicially created doctrine of obviousness-type double patenting over each of:
 - 4A). claims 8-11 of application 09/578,291 in view of Garvin (US 4,355,369) and Wagner (09/578,291 [sic]).

- 4B). claims 1, 25, 26, and 30 of application 10/990,334 in view of Garvin.
- 4C). claims 1, 25, 26, and 30 of application 11/135,948 in view of Garvin.
- 4D). claims 8-9 and 11 of application 11/033,601 in view of Wagner (5,742,845).
- 4E). claims [sic] of application 09/578,312 in view of Garvin.
- 5). Claim 13 was provisionally rejected as unpatentable under the judicially created doctrine of obviousness-type double patenting over each of:
 - 5A). claim 1 of application 10/356,849 in view of Wagner (5,742,845).
 - 5B). claim 1 of application 10/357,145 in view of Wagner (5,742,845).
 - 5C). claims 21 and 24 of application 10/430,123.
 - 5D). claim 14 of application 10/980,345 in view of Garvin and Wagner (5,742,845).

The 35 U.S.C. § 112, First Paragraph, Rejection

Claim 12 has been rejected as being a “single means claim.” Applicants respectfully traverse the rejection of claim 12 for the reasons already set forth in the Appeal Brief dated December 17, 2004, which is herein incorporated by reference. Applicants' application meets the requirements of 35 U.S.C. § 112, first paragraph.

The Office's reliance on *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) is misguided. The issue in *In re Hyatt* specifically involved a claim having a means-plus-function format. Claim 12 does not include a means-plus-function format. Claim 12 does not use “means” or “means for.” Claim 12 does not invoke 35 U.S.C. § 112, sixth paragraph. Thus, claim 12 cannot be a “single means claim”, as the Office alleges.

Furthermore, there is nothing wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. Applicants' functional limitation is used in association with an element to define a particular capability or purpose that is served by the recited element. The recited functional limitation serves to precisely define present structural attributes of the claimed invention. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). MPEP § 2173.05(g).

The Action's comment that “there are not [sic] distinct functions that make the device of claim 12 an ATM” is without merit. Nor is the comment a 35 U.S.C. § 112, first paragraph, issue. The Action's comment is analogous to saying that “there are no distinct functions that make an Appeal Brief an Appeal Brief.” Applicants are not required to recite apparatus structure at the atomic level. The Office's own patent classification system recognizes an “ATM” (e.g., class/subclass 705/43). Claim 12 also finds support in Applicants' disclosure. It is respectfully submitted that the 35 U.S.C. § 112, first paragraph rejection is improper and should be withdrawn.

The 35 U.S.C. § 112, Second Paragraph, Rejection

This is a newly presented ground of rejection for claim 8. Applicants respectfully traverse this new rejection. Nevertheless, claim 8 has been amended as requested to advance prosecution.

The 35 U.S.C. § 101 Rejections

The relied upon application claims do not recite the *same* invention as set forth in pending claim 1. Applicants' application meets the requirements of 35 U.S.C. § 101.

Application 10/980,209

For example, pending claim 1 is directed to an apparatus comprising an automated banking machine. Claim 1 of application 10/980,209 (as set forth in the preliminary amendment filed November 2, 2004) is directed to a method. These claims are not reciting the *same* invention, as alleged in the Action.

Application 10/957,287

For example, claim 1 of application 10/957,287 (as set forth in the preliminary amendment filed September 30, 2004) includes screening software. Where does pending claim 1 include screening software? These claims are not reciting the *same* invention, as alleged in the Action.

The Obviousness-Type Double Patenting Rejections of Claim 1

Applicants respectfully traverse the obviousness-type double patenting rejections. For example, pending claim 1 is directed to an apparatus, whereas the relied upon claims in applications 09/578,291, 10/990,334, and 11/135,948 are each directed to a method. The Action is silent as to which claims (if any) in application 09/578,312 are being relied upon. Nevertheless, in order to advance prosecution, terminal disclaimers are filed herewith with regard to U.S. Applications 09/578,291; 10/990,334; 11/135,948; and 09/578,312. Acceptance thereof is respectfully requested.

Application 11/033,601 in view of Wagner

Claims 8-9 and 11 of application 11/033,601 were canceled in the preliminary amendment filed January 12, 2005. Thus, the rejections based on these claims are moot.

The Obviousness-Type Double Patenting Rejections of Claim 13

Applicants respectfully traverse the obviousness-type double patenting rejections. For example, pending claim 13 is directed to a method, whereas the relied upon claims in applications 10/356,849 and 10/357,145 are each directed to an article. Likewise, the relied upon claims in application 10/430,123 are directed to an apparatus. Nevertheless, in order to advance prosecution, terminal disclaimers are filed herewith with regard to U.S. Applications 10/356,849; 10/357,145; 10/430,123; and 10/980,345. Acceptance thereof is respectfully requested.

Conclusion

For the reasons provided above it is respectfully submitted that all of the rejections should be withdrawn. Applicants respectfully submit that this application is in condition for allowance.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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